

### R E M A R K S

Careful review and examination of the subject application are noted and appreciated. Please cancel claims 2 and 15 without prejudice.

### SHOWING UNDER 37 CFR §1.116

After a final rejection, an amendment canceling claims may be made (37 CFR §1.116(b)(1)). Also, an amendment touching the merits of the application may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented (37 CFR §1.116(b)(3)). The amendments presented herein either cancel claims or are necessary to rebut the new ground of rejection presented for the first time in the final Office Action.

Furthermore, the amendments involve incorporating subject matter from the cancelled dependent claims and, therefore, are believed to better focus, if not remove issues for appeal, or require only a cursory review by the Examiner in conjunction with the arguments presented to rebut the rejections of the dependent claims. As such, the amendments presented herein are believed to be compliant with the showing requirement under 37 CFR §1.116(b)(3) and Applicants respectfully request that the amendments be admitted.

### **SUPPORT FOR CLAIM AMENDMENTS**

Support for the amendments to the claims can be found in the drawings as originally filed, for example, in FIGS. 2 and 3, and in the specification as originally filed, for example, on page 7, lines 1-10, and on page 7, line 17 through page 8, line 17. As such, no new matter has been introduced.

### **CLAIM REJECTIONS UNDER 35 U.S.C. §102**

The rejection of claims 1, 4, 5, 9-11, 13, 14, 18 and 20 under 35 U.S.C. §102(e) as being anticipated by Au (U.S. Patent No. 6,646,578) has been obviated by amendment and should be withdrawn.

The presently claimed invention (claim 1) provides a method for decoding a bitstream, comprising the steps of: (A) accepting a common slice containing a plurality of macroblocks, where the plurality of macroblocks switch from non-I\_PCM mode macroblocks to I\_PCM mode macroblocks in macroblock scan order, (B) generating a first signal comprising the non-I\_PCM mode macroblocks and a second signal comprising the I\_PCM mode macroblocks by parsing the common slice in the bitstream, (C) generating a third signal by entropy decoding the first signal and (D) generating a video signal by combining the second signal and the third signal. Claims 9 and 13 recite similar limitations. With respect to claim 1, the Office Action states that Au fails to disclose the feature of switching from non-I\_PCM mode macroblocks to I\_PCM mode

macroblocks in macroblock scan order, as now recited in claim 1. As such, the presently claimed invention is fully patentable over Au and the rejection should be withdrawn.

With respect to claim 14, the presently claimed invention provides a method for encoding a video signal, comprising the steps of: (A) generating a first signal comprising non-PCM coded data and a second signal comprising PCM coded data by parsing the video signal, (B) generating a third signal by entropy encoding the first signal and (C) generating a bitstream by combining the second signal and the third signal within a common slice, where the common slice comprises pulse code modulation (PCM) coded data and non-PCM coded data. The Office Action fails to allege, let alone factually establish that Au alone discloses or suggests generating a bitstream by combining the second signal and the third signal within a common slice, where the common slice comprises pulse code modulation (PCM) coded data and non-PCM coded data, as presently claimed (see page 12, lines 6-23 of the Office Action discussing claim 15). Specifically, the Office Action does not appear to have addressed why one of ordinary skill in the art would have considered Au as disclosing or suggesting the explicitly recited limitations of canceled claim 15 which have been incorporated into claim 14 (see page 12, lines 6-23 of the Office Action discussing claim 15). As such, the presently pending claim 14 is fully patentable over Au and the rejection should be withdrawn.

Claims 4, 5, 10, 11, 13, 18 and 20 depend, directly or indirectly, from either claim 1, claim 9 or claim 14 which are believed to be allowable. As such, the presently claimed invention is fully patentable over Au and the rejection under 35 U.S.C. 102 should be withdrawn.

**CLAIM REJECTIONS UNDER 35 U.S.C. §103**

The rejection of claims 2, 3, 6-8, 12, 15-17, 19 and 21-26 under 35 U.S.C. §103(a) as being unpatentable over Au in view of Marpe et al. (U.S. Patent No. 6,894,628; hereinafter Marpe) is respectfully traversed and should be withdrawn.

An Applicant may overcome a 35 U.S.C. §103 rejection based on a combination of references by showing completion of the invention by the Applicant prior to the effective date of any of the references (MPEP §715.02(I)). The Applicant need not antedate the reference with the earliest filing date (MPEP §715.02(I)). The Applicant may antedate a reference by providing evidence of prior conception of the invention coupled with reasonable diligence beginning prior to the effective reference date until either an actual reduction to practice of the invention or the filing of the patent application (see 37 CFR 1.131(b)). Proof of reasonable diligence does not require the inventor to work constantly on the invention or to drop all other work (*Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed.

Cir. 2001), reh'g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986)).

The earliest effective priority date of Marpe is July 17, 2003. In particular, Marpe has a filing date of July 17, 2003 (see Marpe at page 1, item (22)). The present invention was conceived prior to July 17, 2003, the earliest effective priority date of Marpe. Specifically, on June 29, 2007, Applicants submitted a Response After Final which included a Declaration under 37 CFR §1.131 accompanied by exhibits showing conception of the present invention prior to May 28, 2003 (see the Response After Final and Declaration under 37 CFR §1.131 filed June 29, 2007, entered by the Examiner on August 2, 2007). In particular, the present invention was conceived prior to May 28, 2003 (see paragraph no. 5 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131). May 28, 2003 is clearly earlier than July 17, 2003 (the earliest effective priority date of Marpe). Therefore, the earliest effective filing date of Marpe is after the conception of the present invention.

The Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and the associated Exhibits A-F provides evidence of the prior conception and diligence up to the filing date (i.e., July 22, 2003) of the present application (see paragraph nos. 5-13 of the Declaration of Lowell L. Winger and Eric

C. Pearson under 37 CFR §1.131). Specifically, the LSI Invention Disclosure Form, drawings and figures in Exhibit A clearly provide demonstrative evidence of the conception of the presently claimed invention. In particular, paragraph 5 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 specifically refers to the material in Exhibit A as showing the conception of the claimed invention.

Furthermore, paragraph no. 7 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 stated that the attached Exhibit A corresponding to the LSI Corporation Invention Disclosure Form, Diagrams #1 and #2 and Figures #3 and #4 **describe the claimed invention** and convey information sufficient to enable one skilled in the relevant art **to make and use the claimed invention**. The claimed invention is described and encompassed by all of the pending claims, not just the three example embodiments mentioned in paragraphs 2-4. Paragraph no. 7 further states that there is a direct correspondence between the diagrams and figures in Exhibit A and the figures of the presently pending application. Specifically, FIGS. 2-5 of the present application correspond to the Diagrams #1 and #2 and Figures #3 and #4 on pages 5-9 of Exhibit A.

Furthermore, the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 further states that the pages 1-4 of the LSI Invention Disclosure Form in Exhibit A show an original

document date which was before May 28, 2003. Paragraph no. 8 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 states that the material in Exhibit A was submitted to LSI's legal department prior to May 28, 2003. The fact that the dates have been redacted does not alter the document's ability to evidence that the conception of the presently claimed invention occurred prior to May 28, 2003 (see MPEP §715.07 II ESTABLISHMENT OF DATES). Thus, the attached Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and the associated Exhibits A-F provide evidence of (i) the conception of the present invention prior to the earliest effective date of the Marpe reference and (ii) diligence up to the filing date (i.e., July 22, 2003) of the present application (see paragraph nos. 5-13 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and Exhibits A-F). Therefore, Marpe is not available as prior art against the claims. As such, the rejection based upon the combination of Au and Marpe does not appear to be sustainable should be withdrawn.

Furthermore, MPEP §715.02(I) states that an Applicants 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed **or something falling within the claim(s)** prior to the effective date of the reference being antedated (MPEP §715.02(I)). The Office Action fails to cite any Authority for the position that the Declaration of Lowell L. Winger and Eric C.

Pearson under 37 CFR §1.131 and Exhibits (A-F) applies only to the claims listed in the Declaration rather than to the claimed invention as recited in paragraph no. 7 of the Declaration. Furthermore, the Office Action fails to present any explanation of why the material contained within the LSI Invention Disclosure Form in Exhibit A accompanying the Declaration is considered not to show possession of either the whole invention as claimed or something falling within the claim(s) as recited in MPEP §715.02(I). As such, the Office's refusal to give effect to the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and the accompanying Exhibits A-F does not appear to be proper. Applicants' representative respectfully requests that the Examiner provide citation to the specific authority that requires an antedating declaration under 37 CFR 1.131 to explicitly recite each and every pending claim in order to be effective to antedate a reference under MPEP §715.02(I) or withdrawn the rejection.

Claims 2-8, 10-12 and 15-26 depend, directly or indirectly, from either claim 1, claim 9 or claim 14 which are believed to be allowable. As such, the rejection does not appear to be sustainable and should be withdrawn.

Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

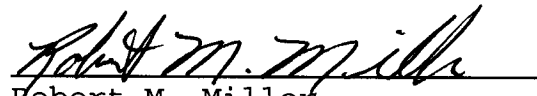


The Examiner is respectfully invited to call the Applicants' representative between 9 a.m. and 5 p.m. ET at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

A handwritten signature in cursive script, appearing to read "Robert M. Miller", is written over a horizontal line.

Robert M. Miller  
Registration No. 42,892

Dated: July 28, 2008

c/o Lloyd Sadler  
LSI Corporation

Docket No.: 03-0781 / 1496.00317